

REMARKS

Claims 1-24 were examined and reported in the Office Action. Claims 1 and 18 are amended. Claims 1-24 are rejected. Claims 1-24 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. §103

It is asserted in the Office Action that claims 1-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,484,156 issued To Gupta et al. ("Gupta") in view of U.S. Patent No. 6,614,847 issued To Das et al. ("Das"). Applicant respectfully traverses the aforementioned rejections for the following reasons.

According to MPEP §2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claim 1 contains the limitations of "[a] moving picture mailing system comprising: a video signal capturing device for capturing digital video signals

from video signal information of moving pictures; an audio signal capturing device for capturing digital audio signals from audio signal information of moving pictures; and a moving picture recorder for respectively receiving the video and audio signals from the video and audio signal capturing devices, compressing the video and audio signals using MPEG-4 video and audio compression techniques, multiplexing the compressed signals and transmitting combined bit streams to a moving picture mailing server; wherein when mail is transmitted to the moving picture mailing server according to user request, the moving picture recorder transmits the combined bit streams to the moving picture mailing server in realtime together with the mail."

Applicant's claim 18 contains the limitations of "[a] moving picture mailing method comprising: (a) capturing digital video and audio signals from information on video and audio signals of moving pictures; (b) compressing the video and audio signals using MPEG-4 video and audio compression techniques; and (c) multiplexing the compressed signals and transmitting combined bit streams to a moving picture mailing server, wherein when the mail is transmitted to the moving picture mailing server according to user request, the combined bit streams are transmitted to the moving picture mailing server in realtime together with the mail."

In other words, in Applicant's claimed invention when mail is transmitted to a moving picture mailing server according to user request, a moving picture recorder transmits combined bit streams to the moving picture mailing server in realtime together with the mail without user intervention.

Gupta discloses an annotation server using a hierarchical annotation storage structure to maintain a correspondence between multimedia stream annotations and a hierarchical group identifier. It is asserted in the Office Action that Gupta discloses a moving picture mailing system by piecing together assertions disclosed in Gupta. Specifically, because Gupta mentions that a title field representing an annotation can contain motion video images and that an annotation server communicates with an email server, which uses SMTP, that Gupta, therefore, discloses a moving picture mailing system. This is a very tenuous argument, at best. Also, it is asserted in the

Office Action that Gupta discloses an audio signal capturing device for capturing digital audio signals from audio signal information of moving pictures because Gupta asserts a microphone may be used so that a user can enter commands and information through an input device, such as a microphone. Applicant does not see how a microphone used as an input device for inputting commands can read on "an audio signal capturing device for capturing digital audio signals from audio signal information of moving pictures." The two are completely different and have different purposes.

Further, it is asserted in the Office Action that Gupta discloses a moving picture recorder for respectively receiving the video and audio signals because Gupta discloses pre-delivered media (rather than streaming media) is media, such as media previously stored at the client computers 15 via the network 16, via removable magnetic or optical disks. An ordinary person skilled in the art, however, would understand the difference between a media storage device and a moving picture recorder for respectively receiving the video and audio signals from video and audio capturing devices. Applicant notes that a capturing device and a recording device are very different.

Moreover, it is asserted in the Office Action that Gupta discloses transmitting the combined bit streams to a moving picture mail server. Applicant notes that a moving picture mail server is not the same as an email server. And, an ordinary skilled person in the art would know that an email server using SMTP accepts email and emails with attached files, but not transmissions of a combined audio and video bit stream.

Further, Gupta does not teach, disclose or suggest "when the mail is transmitted to the moving picture mailing server according to user request, the combined bit streams are transmitted to the moving picture mailing server in realtime together with the mail."

Das is relied on for simply disclosing that MPEG-4 is desirable for multimedia compression. Das simply asserts different types of compression available for digital video. Further, Das does not teach, disclose or suggest "when the mail is transmitted to the moving picture mailing server according to user request, the combined bit streams are transmitted to the moving picture mailing server in realtime together with the mail."

Based on the pieced together assertions in the Office Action, by viewing the disclosures of Gupta and Das, one simply can not jump to the conclusion of obviousness without using impermissible hindsight. According to MPEP 2142, [t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to a moving picture mailing system including all of the limitations of original claim 1 and claim 18.

Neither Gupta, Das, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's claims 1 and 18, as listed above. Since neither Gupta, Dad, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claims 1 and 18, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's claims 1 and 18 are not obvious over Gupta in view of Das since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claims 1

and 18, namely claims 2-17, and 19-24, respectively, would also not be obvious over Gupta in view of Das for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for Claims 1-24 are respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely 1-24, patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on July 29, 2004, Applicant respectfully petitions the Commissioner for a three (3) month extension of time, extending the period for response to January 29, 2005. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$510.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(3) small entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: January 21, 2005

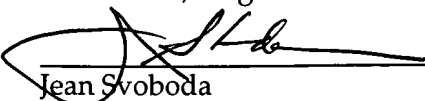


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on January 21, 2005.



Jean Svoboda